

REMARKS

Claims 17, 18, 21, and 22 stand newly rejected after having been affirmed by the BPAI.

This response adds claims 36-39. Support for the added claims is found in the specification and drawings, including one or more priority parent applications incorporated by reference. No new matter is intended to be added. For instance, but without limitation, the specification and drawings provide a tissue stop, such as a knock out pin 36, where the knock out pin is operatively associated with a vacuum hub H.

103 Rejection:

Claims 17 and 18 are rejected as obvious over Silverman (2198310) in view of Rubinstein et al. (5462062). This rejection is improper for at least the following reasons.

First, the BPAI decision at page nine explains that the Examiner did not provide a prima facie case that it would be obvious to replace Silverman's split needle with features from another reference (Reznik). It is respectfully urged that the Examiner has also failed to provide a prima facie case regarding modifying Silverman by Rubinstein.

The Examiner agrees Silverman fails to disclose a plurality of hooked extractors, but goes on to state that Rubenstein discloses

“.. use of a pair of sharp-edged blades (44a,44b) attached to hinges (42a,42b) at opposite edges on the interior of a biopsy needle (Col 3, lines 8-11). The inclusion of such a blade and hinge to each portion of the inner member disclosed by Silverman would form a pair of hooked extractors. It would have been obvious to one skilled in the art at the time the invention was made to modify the distal end of the needled disclosed by Silverman to include a pair of sharp edged blades attached to hinges as taught by Rubinstein

et al in order to aid in severing the biopsy and retaining the biopsy in place as the inner member is removed from the patient.”

It is respectfully urged that the Examiner’s proposed modification is improper for at least the reasons.

Silverman teaches first plunging outer needle 10 into tissue, then inserting interior needle having a shank 14 and “divergently pointed and beveled extremities” 17 through the outer needle into tissue. According to Silverman, this action causes the points 17, by reason of their beveled extremities, to be spread apart. According to Silverman, the next step is further insertion of the outer needle 10 to enclose the interior needle. Silverman explains that “This action causes the split portion of interior needle to be compressed together, thus firmly enclosing the desired specimen”. Underlining added. Col 2, lines 3-24 of Silverman.

So Silverman teaches inserting the inner needle through the outer needle into tissue to spread apart divergently pointed extremities of the split end, and then enclosing the interior needle with the outer needle to compress the split ends of Silverman’s inner needle together.

Accordingly, it is respectfully urged one would not add blades to the inner needle of Silverman, as the Examiner suggests, because

(1) Silverman teaches that the split portion of the inner needle should be divergent and spread apart as the needle is directed through the outer needle and into tissue, such that the split portion can encapsulate tissue and then be compressed together by the outer needle. This is contrary to the use of a hinged blade of Rubinstein which is shown pointing radially inward in both Figures 3B and Figure 3D of Rubenstein.

(2) the hinged blades of Rubenstein, if added to the interior needle of Silverman would close off the distal end of the interior needle as the inner needle is inserted through the outer needle of silvman into tissue. See Figures 3B and 3D of Rubenstein showing the blades 44A/B at least partially closing the end of the needle 40 even in the “open” configuration of Figure 3B.

In addition, Rubenstein's Figure 5A/5B and related disclosure teaches an embodiment using an inner tube 76 and an outer tube 72 with an "inwardly tapered end" 74. The inner tube 76 has blades 76a and 76b. Rubenstein teaches the blades 76A and 76B engage the tapered end 74 of the outer tube 72. So Rubenstein's teaching or suggestion with respect to use of inner and outer needles or needle portions would not suggest the Examiner's proposed combination, but would instead result (at most) in one making Silverman's outer needle have a inwardly tapered end...and this would clearly not be operative with Silverman's inner needle, even if one did add blades to Silverman's inner needle.

Accordingly, the Examiner's proposed combination is not taught or suggested by the prior art, and it is respectfully urged that even if one attempted to modify Silverman by the teachings of Rubenstein, the result would be inoperability of Silverman, or at best, blades that would at least partially occlude the inner needles ability to receive tissue, and which would be contrary to Silverman's desire to have an inner needle with divergent tips to encapsulate tissue when the inner needle is inserted into tissue.

It is respectfully urged that the rejection of claims 18, 21, and 22 is improper for at least the reasons set forth above with respect to Claim 17.